REMARKS

Appellants' representative steadfastly maintains that McCollom, *et al.* (U.S. 6,343,274 B1) fails to teach, suggest, motivate and/or disclose the subject invention as claimed. For at least the reasons herein stated a reversal of the Examiner's rejections is respectfully requested.

1. Rejection of Claims 1-4, 6-14, and 16-20 Under U.S.C. §102(e)

A. McCollom, et al fails to disclose, teach, or suggest transmitting information to an entity associated with an ad or display message upon detecting activation of the ad or display message.

Appellants' representative respectfully disagrees with the Examiner's assertion in his Answer to Appellants' Brief that the time in which information is transferred does not patentably distinguish the claimed invention from the prior art.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that "***each and every element as set forth in the claim*** is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Claims 1, 8, 11, and 18 recite in part ...transmitting information ***to an entity associated with an ad*** or display message ***upon detecting activation of the ad*** or display message. McCollom, *et al.* provides for physically separating the merchant advertiser from the system collecting consumer information by employing a third party intermediary namely the commerce server--a database of advertisements. McCollom, *et al.* discloses an extensive system in which the commerce server collects consumer information and physically separates such information from an entity associated with the ad. An entity associated with the ad includes, according to the specification, an advertiser sponsoring the ad, a business or other organization (See page 13, lines 22-23). Thus, the commerce server physically separates consumer information from the merchant advertiser (*i.e.*, the business or organization sponsoring the ad).

More specifically, McCollom, *et al.* discloses a process in which a merchant signs up and purchases the services of the third party commerce server to collect consumer information and

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possibly provide the merchant with statistical reports on the consumers who are interested in their products. Accordingly, information is not transmitted to an entity associated with an ad or display message (*e.g.*, a merchant advertiser) upon detecting activation of the ad or display message (*e.g.*, clicking-on an ad...), rather the information is collected centrally by a third party commerce server and is only transmitted to the entity associated with an ad (i) at a later time after a laborious process in which the commerce server aggregates data and produces reports and (ii) only when the reports are requested by the entity associated with the ad or display message.

Furthermore, McCollom, *et al.* teaches away from transmitting information directly to an entity related to an ad or display message upon detecting activation of the ad or display message.

> A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or ***would be led in a direction divergent from the path that was taken by the applicant.*** *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994); *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999) (emphasis added).

The main purpose for the system of McCollom, *et al.* is to provide protect consumer information and thereby consumer privacy (See Col. 1, lines 42-63). McCollom, *et al.* specifically states "Unfortunately, as the Internet provides public access to advertisements on a merchant server this access can allow the merchant to collect information that the consumer may wish to keep private." Col. 1, lines 56-59. Thus, McCollom, *et al.* rejects the idea of transmitting consumer information directly to merchants in favor of a system isolating merchant advertisers from consumers *via* a third party system. This teaches away from the subject invention where consumer privacy is protected by collecting less specific information about consumers and their preferences but nevertheless transferring such information directly to the advertiser for instance when an ad is clicked-on. Such a system and methodology thereby enables an advertiser to tailor his web site to a particular user based on the information received from the user's interaction with a merchant's ad, for example.

Hence, McCollom, *et al.* fails to disclose teach or suggest all the claim limitations of the subject application. In view of at least the foregoing reasons, reversal of the rejection is respectfully requested.

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B. McCollom, et al. fails to disclose, teach or suggest transmitting information regarding the current cluster.

In his Answer to Appellants' Brief, the Examiner continues to assert that it is inherent in McCollom, *et al.* to transfer information regarding the current cluster, because in one embodiment McCollum, *et al.* discloses a consumer program that transmits to each merchant ID advertisement and each category of advertisement statistical information for each advertisement the consumer has viewed. Applicants' representative insistently disagrees.

> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.2d 743, 49 U.S.P.Q.2D (BNA) 1949 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).
>
> Additionally, for a reference to anticipate "...the reference must be enabling and describe the applicant's claimed invention sufficiently ***to have placed it in possession of a person of ordinary skill in the field of the invention***." *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (emphasis added).

The mere fact that McCollom, *et al.* transfers statistical information about advertisements viewed by consumers is not enough to have placed a person of ordinary skill in the art in possession of the claimed invention. As mentioned above, McCollom, *et al.* collects vast amounts of consumer information from the consumers themselves and protects them from having private or personal information revealed to merchants by utilizing a third party commerce server to prepare and transfer statistical information. The present invention as claimed allows information regarding consumers to be transferred directly to merchant advertisers and protects consumer privacy by inferring consumer attributes from the current cluster of ads from which a merchant's ad was selected, for example. Retrieving or inferring consumer information from a cluster of ads is neither disclosed, taught, nor suggested by McCollom, *et al.* Necessarily, McCollom, *et al.* fails to disclose, teach, or suggest transmitting information regarding the current cluster. Reversal of this rejection is hereby

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respectfully requested for at least this reason.

C. *McCollom, et al. fails to disclose, teach, or suggest transmitting information regarding the current cluster or ads having a selection probability.*

Applicants' representative respectfully disagrees with the Examiner's Answer to Appellants' Brief in which the Examine asserts that it is inherent to the McCollom, *et al.* system to transmit information regarding the current cluster or ads having a selection probability. The Examiner creatively but improperly alleges that a selection probability is inherent, because the system of McCollom, *et al.* amasses statistical information regarding the ads that a consumer views and subsequently retrieves consumers advertisements based on the collected statistical information such that certain advertisements would have a bias over other advertisements.

> "To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber,* 128 F.3d 1473, 1477, 44 U.S.P.Q.2D (BNA) 1429, 1431 (Fed. Cir. 1997)
>
> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.2d 743, 49 U.S.P.Q.2D (BNA) 1949 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Independent claims 1 and 11 recite selecting an ad to be displayed on a web page as one of a plurality of adds within a current cluster, each of the plurality of ads having a respective selection probability of for being displayed. Claims 8 and 18 recite a display message...having a selection probability within the current cluster for being displayed. Stated differently, claims 1, 8, 11, and 18 recite ads or display messages having a selection probabilities with respect to the cluster in to which the belong. Hence, even if McCollom, *et al.* discloses that certain ads are more likely to be displayed because of information gathered about a consumer's interests, such a disclosure does not inherently disclose display messages or ads having selection probabilities with respect to a current cluster

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especially since McCollom, *et al.* fails to recognize, teach, or suggest the benefits of employing clusters. Accordingly, reversal of this rejection is respectfully requested for at least this reason.

II. Rejection of claims 21-26 Under U.S.C. §103(a)

Claims 21-26 depend from independent claims 1, 8, 11, and 18 and are allowable for at least the same reasons as their respective independent claims. Additionally, the subject matter recited in dependant claims 21-26 provides a separate basis for patentablility over and above those in independent claims 1, 8, 11, and 18.

A. Dynamically tailoring a webpage, ad displayed, display, or display message or automatically changing a web page, display or display message is not taught, suggested, or motivated by the McCollom, et al.

Applicants' representative disagrees with the Examiner's assertion that because consumer information is being collected, it would be obvious to a person of ordinary skill in the art to employ such information to dynamically tailor (or automatically change) a webpage, ad displayed... to a consumer, because "This way each consumer would *receive* only advertisement that is better targeted to his/her needs" (emphasis added). It is respectfully submitted McCollom, *et al.* does not appreciate the benefits of dynamically tailoring webpages, display ads.... at least in part because McCollom, *et al.* does not disseminate unsolicited advertisements to consumers such that dynamic tailoring of ads or web pages would help ensure that each consumer would receive only advertisements targeted to their needs. In fact, McCollom, *et al.* seeks an alternative to unsolicited email and banner advertisement (Col. 2, lines 29-35). Instead, McCollom, *et al.* empowers consumers themselves, *via* consumer software, to solicit, request, or retrieve particular advertisements of interest from a merchant advertisement database (*i.e.*, the commerce server). The consumer software thus enables consumers to determine when and what advertisements they will view (See Col. 2, lines 35-37). Hence, it is submitted that Examiner's rationale purporting to support a case for prima facie obviousness is erroneous. Moreover, the mere fact that McCollom, *et al.* collects information about consumers and their interaction with advertisements and after a period of time distributes non-private information to merchant advertisers does not teach, suggest, or motivate dynamically tailoring (or automatically changing) web pages, display messages, etc. based on the collected information.

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Moreover, other than the disclosure in the instant application, there is no evidence of employing dynamic tailoring based on transmitted information, and absolutely no evidence of utilizing dynamic tailoring based on information regarding the current cluster as recited by claims 23-26. Therefore, it appears that the Examiner's allegations of obviousness are based on improper hindsight, in which the instant application provides the missing teaching and motivation. For at least the aforementioned reasons, reversal of this rejection is respectfully requested.

CONCLUSION

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited reference. Accordingly, it is respectfully requested that the rejections of claims 1-4, 6-14, and 16-26 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,

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